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09/735,681	12/13/2000	Thomas Charles Gilbert	D0932-00230	7999

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EXAMINER

LEE, EDMUND H

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 04/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/735,681

Applicant(s)

GILBERT ET AL.

Examiner

EDMUND H LEE

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 16-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-15, drawn to a polymeric siding panel, classified in class 52, subclass 518.
 - II. Claims 16-20, drawn to a method of making a shaped polymeric article, classified in class 264, subclass 555.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process such as cold-forming a sheet of extruded polymeric material into the patterned sheet.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Joseph Powers on 5/3/01 a provisional election was made without oral traverse to prosecute the invention of group II, claims 16-20. Affirmation of this election must be made by applicant in replying to this Office

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action. Claims 1-15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

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7. The abstract of the disclosure is objected to because it does not mention the steps of the claimed process. Correction is required. See MPEP § 608.01(b).

8. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the *elected* claims are directed.

9. Claims 16-20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for applying vacuum pressure to the hot polymeric material that is above its heat deflection temperature through the rotating belt, does not reasonably provide enablement for applying vacuum pressure to the hot polymeric material through the rotating belt (cl 16, lns 8-10). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The instant specification at paragraph 19 discloses the necessity of the hot polymeric material to be above its heat deflection temperature during the application of the vacuum pressure. There is no disclosure in the instant specification of applying vacuum pressure to the hot polymeric material at any other temperature than above its heat deflection temperature.

10. Claim 20 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for forming the lateral edge portions while the hot polymeric material is above its heat deflection temperature, does not reasonably provide enablement for forming the lateral edge portions. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to

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make and use the invention commensurate in scope with these claims. The instant specification at paragraph 19 discloses the necessity of the hot polymeric material to be above its heat deflection temperature during the formation of the lateral edge portions. There is no disclosure in the instant specification of forming the lateral edge portions in the hot polymeric material without the temperature of the hot polymeric material being above its heat deflection temperature.

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 16 and 20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 10 of U.S. Patent No. 6319456 (hereinafter USPN '456) in view of Epstein et al (USPN 4015391). USPN '456 teaches the all the claimed limitations except using a mold impression resembling a plurality of adjacent shingle impressions of substantially the same length, each of the shingle impressions including a bottom edge, at least one of the bottom edges being beveled to give the appearance of shingles having different lengths. Epstein et al teach a molded polymeric cedar shake panel having a plurality of adjacent

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shingle impressions of substantially the same length, each of the shingle impressions including a bottom edge, at least one of the bottom edges being beveled to give the appearance of shingles having different lengths (figs 2-5). USPN '456 and Epstein et al are combinable because they are analogous with respect to molding polymeric shakes. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to design the mold impression of USPN '456 to mold the cedar shake panel design of Epstein et al in order to efficiently mold a market demanded product.

13. Claims 16-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The step of cooling the pattern sheet below a heat deflection temperature (cl 16, Ins 11-12) is indefinite because there is no previous step of heating the patterned sheet portion above a heat deflection temperature of the polymeric material. If the sheet of extruded hot polymeric material is at a temperature above its heat deflection temperature then it should be positively and clearly recited as such.

The phrase "said shaped sheet" (cl 16, ln 13) lacks antecedent basis in the claim.

Clarification and/or correction is required.

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 16- 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bosler (USPN 5314325) in view of Johnstone et al (USPN 4649008) and Epstein et al (USPN 4015391). In regard to claim 16, Bosler teaches the basic claimed process including a method of manufacturing a shaped polymeric article (figs 1-5); providing a sheet of extruded hot polymeric material (figs 1-5); disposing the sheet onto a rotating belt, the rotating belt including a mold impression therein and a plurality of apertures therethrough, the mold impression resembling siding/shakes (col 7, lns 35-40; col 8, lns 1-13; figs 1-5); applying vacuum pressure to the hot polymeric material through the belt so as to draw the sheet into intimate forming contact with the mold impression to form a patterned central portion (figs 1-5); and cooling the pattern sheet portion below a heat deflection temperature of the polymeric material (col 7, lns 5-20; figs 1-5). However, Bosler does not teach using a mold impression resembling a plurality of adjacent shingle impressions of substantially the same length, each of the shingle impressions including a bottom edge, at least one of the bottom edges being beveled to give the appearance of shingles having different lengths; and severing a length of the shaped sheet to produce a shaped polymeric article. In regard to using a mold impression, Epstein et al teach a molded polymeric cedar shake panel having a plurality of adjacent shingle impressions of substantially the same length, each of the shingle impressions including a bottom edge, at least one of the bottom edges being beveled to give the appearance of shingles having different lengths (figs 2-5). Bosler and Epstein et al are combinable because they are analogous with respect to molding polymeric

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shakes/sidings. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to design the mold impression of Bosler to mold the cedar shake panel design of Epstein et al in order to efficiently mold a market demanded product. In regard to severing, Johnstone et al teach extruding polymeric siding (fig 1); and severing a length of the shaped sheet to produce a shaped polymeric article (fig 1). Bosler and Johnstone et al are combinable because they are analogous with respect to extruded siding/shakes. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to sever the continuous siding of Bosler as taught by Johnstone et al in order to provide useable lengths of siding/shakes. In regard to claims 17-20, Bosler does not teach using cedar shake shingle impressions and a plurality of beveled bottom edges; using alternating beveled bottom edges; using beveled bottom edges in a non-periodic pattern; forming lateral edge portions; and cooling the lateral edge portions below the heat deflection temperature. Bosler teaches forming lateral edge portions (figs 1-5); and cooling the lateral edge portions below the heat deflection temperature (figs 1-5). In regard to using cedar shake shingle impressions and a plurality of beveled bottom edges, Epstein et al teaches molding a polymeric cedar shake having a plurality of beveled bottom edges (fig 3). Since Bosler and Epstein et al are combinable for the above reasons, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the cedar shake design of Epstein et al as the mold impression of Bosler in order to efficiently mold a market demanded product. In regard to using beveled bottom edges in a non-periodic pattern, Epstein et al teaches molding a polymeric cedar shake

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having a plurality of beveled bottom edges in a non-period pattern (fig 3). Since Bosler and Epstein et al are combinable for the above reasons, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the cedar shake design of Epstein et al as the mold impression of Bosler in order to efficiently mold a market demanded product. In regard to using alternating beveled bottom edges, such is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, adjacent cedar shingles having alternating lengths are well-known in the shake/siding art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to design the mold impression of Epstein et al to mold alternating length cedar shingles in order to produce accurate replications of real cedar shakes.

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Both Davis et al (USPN 4680911) and Lamb et al (USPN 5927044) teach the state of the art.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H LEE whose telephone number is 703.305.4019. The examiner can normally be reached on MONDAY-THURSDAY FROM 9AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAN H SILBAUGH can be reached on 703.308.3829. The fax phone numbers for the organization where this application or proceeding is assigned are


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703.305.7718 for regular communications and 703.305.3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0661.


EDMUND H LEE
Examiner
Art Unit 1732
4/22/03

EHL
April 22, 2003